Supreme Court, U.S.
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No. 04-___

IN THE

Supreme Court of the United States

HOUSEY PHARMACEUTICALS, INC.,
Petitioner,

v.

MERCK & CO., INC., ASTRAZENECA UK LTD., ASTRAZENECA LP, ASTRAZENECA PHARMACEUTICALS LP, AVENTIS PHARMACEUTICALS, INC., BRISTOL-MYERS SQUIBB COMPANY, ROCHE HOLDINGS, INC., HOFFMANN-LA ROCHE INC., ROCHE LABORATORIES, INC., SYNTEX (U.S.A.) INC., WYETH, AND WYETH PHARMACEUTICALS INC.,
Respondents.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

Whether the construction of patent claims should be governed by a substance-driven focus on sensibly interpreting claim language so as to capture the advances over prior art, understood from the context of the whole patent document and prosecution history, and avoiding constructions that invalidate the patent where reasonably possible.

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PETITION FOR A WRIT OF CERTIORARI

Housey Pharmaceuticals, Inc. (Housey), petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.[1]

OPINIONS BELOW

The Federal Circuit's opinion (Pet. App. 1a-22a) is reported at 366 F.3d 1348. The district court's opinion on claim construction (Pet. App. 23a, 30a-32a) is not reported.

JURISDICTION

The judgment of the court of appeals was entered on May 7, 2004. Pet. App. 1a. A timely petition for panel and en banc rehearing was denied on August 25, 2004. Pet. App. 33a. This Court has jurisdiction under 28 U.S.C. § 1254(1).

STATEMENT

A. Background

This case involves patents for a method of sifting through substances to see which ones have a particular desirable property—the ability to inhibit or activate a specific pre-identified protein in a cell. The most prominent focus of the patented method is on proteins that have already been recognized to be responsible for the uncontrolled growth that characterizes cancer cells. If substances can be identified that target such a particular protein, they offer the possibility, if turned into therapeutic drugs, of turning off the cancerous growth without the adverse collateral harms to other cells (such as other fast-growing healthy cells) that are caused by cruder therapeutic substances, which attack cancerous growth by means other than targeting the responsible protein. The patented method at issue seeks to discover such specific protein-targeting substances by using a cell line that over-produces the target protein (relative to a control line of cells),

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[1] Pursuant to Rule 29.6, Housey states that it has no parent corporation, and no publicly held company owns 10% or more of its stock.

noticing how a pre-identified cellular property correlates with the increased level of protein (the patents call this a "graded cellular response"), then exposing the protein-overproducing cells and the control line to test substances, and observing whether the substances differentially affect the pre-identified protein-correlated cellular property in the two cell lines.

The new significance of substances that inhibit or activate a particular protein of interest is well explained, for the cancer context, in the recent cover story in *The Economist*, Oct. 16, 2004, at 75 (cover: "Beating cancer: The new frontier of molecular medicine"). "Cancer is characterised by uncontrolled cell growth." *Id.* "Most current therapies—drugs that were developed during the first golden era, in the 1970s—simply attack dividing cells. That stops tumours, but it also kills all rapidly proliferating cells, regardless of their origin, function or state of health. The action of these drugs on normal tissues causes the side effects, including nausea, fatigue and weakened immune systems, associated with cancer treatment. By contrast, the new generation of drugs . . . attack only deranged cells. These drugs are designed to fix the specific molecular problems in a tumour that drive its growth. [¶] The best known of these new drugs is Gleevec[,] . . . designed to halt a blood cancer called chronic myeloid leukaemia (CML)," which is caused by a chromosonal abnormality that produces a "novel protein . . . known as BCR-ABL," "one of a class of enzymes known as tyrosine kinases," which induces cancerous growth. *Id.* "Gleevec blocks the activity of BCR-ABL *by sitting in the enzyme's active site.* This switches off the signal to grow, and the cancer stops proliferating." *Id.* at 76 (emphasis added to indicate that Gleevec binds to the protein). In short, finding substances that selectively bind to identified proteins, and thereby block their activity, is increasingly important, espe-

cially in cancer research. *See* B. Alberts *et al.*, *Molecular Biology of the Cell* 1358-60 (4th ed. 2002).[2]

B. The Patents

Four patents, with Dr. Gerard Housey, MD, PhD, as inventor and Housey Pharmaceuticals now as assignee, are at issue. Pet. App. 2a. All are entitled, "Method of Screening for Protein Inhibitors and Activators." They describe "a general screening method for the *discovery* and *identification* of both inhibitors and activators of enzymes, receptors, and other proteins"—particularly, "a method of screening for substances which *specifically* inhibit or activate a particular protein affecting the cultural or morphological characteristics of the cell expressing the protein . . . ." Patent No. 4,980,281, Col. 1, ll. 7-14 (emphases added).[3] The patents take as already understood the defining characteristic of the substances being sought (inhibitors and activators of a pre-identified protein): the already-understood defining characteristic is, of course, the reason for wanting to find them. The patents then lay out a method of finding such substances—of "discover[ing]" them, of "identif[ying]" them, of "screening for" them.

The specification repeatedly explains that the invention picks out, from among the entire class of substances that affect a particular cell property (*e.g.*, its cancerous growth), the substances that do so by acting *on the protein*, distinguishing

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[2] Gleevec itself is made by Novartis, a licensee of Housey's, whose method of cellular screening with protein-overproducing cells was used to identify the active ingredient in Gleevec as an inhibitor of the protein kinase associated with chronic myelogenous leukemia. *See* Buchdunger *et al.*, *Inhibition of the Abl Protein-Tyrosine Kinase* in Vitro *and* in Vivo *by a 2-Phenylaminopyrimidine Derivative*, 56 Cancer Research 100 (1996); Alberts, *supra*, at 1359-60 (figure shows Gleevec binding). Most of the world's major pharmaceutical companies have licensed the patents at issue.

[3] All citations to the patents, unless otherwise indicated, are to Patent No. 4,980,281, given by column and line numbers.

them from substances that affect the cell property by acting on *other components of the cell*. It achieves this critical experimental separation by the observed differential effect on a carefully selected "phenotypic characteristic" that has been confirmed, before the substance-testing step of the method, as correlating with increasing expression of a "protein of interest" (POI). Col. 2, ll. 40-42, 60-62; Col. 6, ll. 14-17.[4] Thus, the patented method uses the "greater effect on the test lines than on the control lines" (Col. 3, ll. 9-10), the "greater effect on the phenotype of the higher producing cell line" (Col. 4, ll. 49-50), to "distinguish[]" (Col. 3, l. 7), to "identif[y]" (Col. 4, l. 48), the desired subgroup among all cell-property-affecting substances. It is not too much to say that the making of this separation is the essence of this invention.

Immediately after the general "Field of the Invention" para graph (Col. 1, ll. 7-15), the specification describes prior-art assays (screening methods) for the crucial purpose of identifying the inventive contribution here—the advance over the prior art. Col. 1, l. 16-Col. 2, l. 22. It notes several prior-art "assay systems" used "for the discovery of new modulators of cell growth, and in particular, in the search for new anti-cancer drugs which are specifically toxic to cancer cells but not to normal cells." Col. 1, ll. 17-21. Thus, "[i]n vitro cytotoxicity assays" (lab-dish testing for toxicity to cells) measure "the inhibition of certain cellular metabolic pathways in response to treatment with cytotoxic agents," but because what is tested is inhibition of the overall multi-step "pathways" through which some cellular process (metabolism) takes place, without being limited to the targeted blocking of a selected protein within such pathways, they "are

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[4] In biology, a "phenotype" is contrasted with a "genotype." A "genotype" is the *genetic* constitution of a cell or organism. "Phenotype" is the broad, catchall term embracing the set of discernable features of the cell or organism (generated by its genetic code as it interacts with its environment)—including its growth rate, shape ("morphology"), and other characteristics.

non-specific since any agent which alters the growth properties of cells will score positively in these assay systems." Col. 1, ll. 28, 31-33, 38-40. Again, certain prior-art assays conducted in (gelatin-like) soft agar are "also non-specific" because "any agent which inhibits cellular growth *in any way* will score[] positively in this assay system as it is currently used, whether or not it inhibits the protein of interest." Col. 1, ll. 51-59 (emphasis added). The specification also describes another prior-art method (Uehara) as "currently the most effective one for developing specific agents which [either] interact with a given protein *or* alter a specific cellular property" (Col. 2, ll. 12-14 (emphasis added; "either" inserted for emphasis)). In all these descriptions, the specification identifies the limitation of the pre-existing methods: they merely find substances that can modulate a cellular property of interest (*e.g.*, cancerous growth); they do not sift among such substances to find those which achieve that effect by specifically interacting with an identified protein, rather than through other mechanisms.

Having identified the limiting character of prior-art methods, the specification several times pinpoints that the new method makes the very separation prior-art methods do not. Thus, it immediately distinguishes the new method as exceeding the "specificity" of the just-described Uehara method (Col. 2, ll. 26-27) and declares that the new method involves

> the generation of a cell line purposefully engineered to detect both stimulatory and inhibitory agents which are *absolutely specific for any given protein* which affects the cultural or morphological characteristics of the cell.

Col. 2, ll. 29-33 (emphasis added). Distinguishing among cell-property-altering substances, the specification says that the claimed assay tells investigators which kind they have found: "Substances which *specifically inhibit or []activate the POI* may be distinguished from substances which affect cell morphology or growth *by other mechanisms* in that they

will have a greater effect on the test lines than on the control lines." Col. 3, ll. 5-10 (emphasis added). After describing the basic idea of creating a POI-overproducing cell line, and calling for any kind of "phenotypic characteristic" that correlates with the level of that protein (Col. 4, l. 51-Col. 6, l. 13), the specification again stresses the crucial distinction among ways of altering cell properties (Col. 6, ll. 14-20 (emphasis added)):

> What we are looking for is a increase in the phenotypic change exhibited by the cell which becomes greater with increasing expression of the POI. We call this a "graded cellular response," and it is by this specialized response that *we distinguish inhibitors or activators of the POI from agents that act upon other cell metabolites to effect a phenotypic change.*

Much of the rest of the specification is taken up with details showing how to prepare protein-overproducing cells—mostly focused on the cancer-causing protein kinase C (PKC), an enzyme—and to identify phenotypic characteristics correlated with the protein level (*e.g.*, formation of clumps called foci as cells grow, the ability to grow suspended in a gelatinous medium called soft agar). Near the end, the specification reports certain experiments and says (Col. 18, ll. 31-36 (emphasis added)):

> this work establishes, for the first time, the fact that stable overproduction of a protein in mammalian cells can result in a novel cellular phenotype(s) (in this case anchorage independence) which can be *directly modulated by chemical agents which interact with the protein.*

Claim 1 of the earliest patent, the '281 patent, claims a "method of determining whether a substance is an inhibitor or activator of a protein." The method includes ("comprises," in patent language) the steps of taking two cell lines carefully differentiated by the level of a specified protein, exposing them to a substance one is trying to test, and observing whether the test substance has a differential effect

on a pre-selected property ("phenotypic characteristic") of the cell lines that has been correlated with the protein level. *See* Pet. App. 3a-4a.

> 1. A method of determining whether a substance is an inhibitor or activator of a protein whose production by a cell evokes a responsive change in a phenotypic characteristic other than the level of said protein in said cell per se, which comprises:
>
> (a) providing a first cell line which produces said protein and exhibits said phenotypic response to the protein;
>
> (b) providing a second cell line which produces the protein at a lower level than the first cell line, or does not produce[] the protein at all, and which exhibits said phenotypic response to the protein to a lesser degree or not at all;
>
> (c) incubating the substance with the first and second cell lines; and
>
> (d) comparing the phenotypic response of the first cell line to the substance with the phenotypic response of the second cell line to the substance.

One dependent claim, '281 Patent, Claim 8, claims that method applied particularly to an enzyme. Other claims in the patents claim variations on that basic method.

C. District Court Proceedings

Housey brought a patent infringement action against respondents. For purposes of construing the claims at issue, the district court proceedings were consolidated with an earlier declaratory-judgment action brought by Bayer AG against Housey. *See* Pet. App. 2a. The district court rendered constructions of several patent claim terms in the Bayer case, constructions that also applied in this case. Pet. App. 23a, 30a-32a. The court concluded, in particular, that an "inhibitor or activator of a protein" is any "substance that has

a greater effect on the phenotype of cells that express the protein of interest at a higher level than on the phenotype of cells that express the protein of interest at a lower level or not at all." Pet. App. 31a. In other words, the court *defined* the object of search in this screening method, an "inhibitor or activator of a protein," as any substance that has the differential effect on the two cell lines that the method looks for. That construction makes the method, by definition, a 100% perfect identifier of whether a substance is an inhibitor or activator of a protein. At the same time, though, the district court construed "method of determining" *not* to require the answer of the screening method to be "100% certain," concluding instead that (as in science generally) "determining" here means "ascertaining with a high degree of probability that an unknown or suspected substance is an activator or inhibitor of a target protein." Pet. App. 32a.

A few weeks after the claim-construction ruling, respondents and Housey stipulated that the patents were invalid and not infringed under the district court's construction of "inhibitor or activator of a protein." Pet. App. 24a-29a. On that basis the court entered judgment. Pet. App. 23a.

D. The Court of Appeals Decision

A divided panel of the court of appeals affirmed the construction of "inhibitor or activator of a protein" and, therefore, the judgment. Pet. App. 1a-14a. The majority adopted the district court's construction of "inhibitor or activator of a protein" as meaning any substance that produces a greater effect on a phenotypic characteristic of the protein-overproducing cell lines than on control cells, regardless of how that effect is achieved. Pet. App. 2a, 7a. Because the stipulated judgment depended expressly on the particular construction the district court adopted, any different construction by the court of appeals would have required a remand.

The majority began by stating that "a discernable plain and ordinary meaning of the claim language . . . usually defines the scope of the claims unless the patentee has explicitly disclaimed or clearly disavowed this meaning in the specification or prosecution history." Pet. App. 6a-7a. The majority then analyzed this case. In two paragraphs it drew a conclusion about the proper meaning from the claim language itself and two statements in the specification—without considering what sense this construction made, the overall context of the patent documents to determine how to capture the advance over prior art, or the stipulated invalidity under that construction. Pet. App. 7a-8a.

The majority drew its conclusion from the "language of claim 1 of the '281 patent," which it declared was "inimical" to any different construction. Pet. App. 7a. It concluded, simply, that a substance that has a differential effect on the two cell lines "is, as *defined by* the claimed method itself, an inhibitor or activator of the protein of interest." *Id.* (emphasis added). Against the backdrop of its conclusion that the claim language was "inimical to any narrower construction," the majority said that "inhibitor or activator of a protein" was "expressly define[d]" by statements in the specification that such substances "are *identified* by their" differential effect on the two cell lines (Col. 4, ll. 48-50) and can be "*distinguished* from substances which affect cell morphology or growth by other mechanisms in that they will have greater effect on the test lines than on the control lines" (Col. 3, ll. 5-10). Pet. App. 7a-8a (emphases added). The majority rejected Housey's central contention that this construction confuses a high-probability way of finding (distinguishing, identifying) "inhibitors or activators of a protein" with the *definition* of what one is looking for. Pet. App. 8a. The majority reasoned that, because the claim "addresses a method of determining whether a compound is an inhibitor or activator that is conducted by observing whether a particular event occurs when the method is performed," it is "logical to

construe an 'inhibitor or activator of a protein' as a substance that precipitates that event." *Id.*

The foregoing reasoning is the sum total of the support the majority offered for its construction. The remainder of its opinion addresses only the merits of Housey's construction. Housey proposed that "inhibitor or activator of a protein" refers to substances that achieve their modulating effect on the cellular activity of the protein by binding to the protein (or the multi-part molecular complex of which it is a part, as the prosecution history explains), not by other means. The majority offered several reasons for rejecting that construction.

As to claim language, the majority recognized that standard technical dictionaries include definitions of "activator" and "inhibitor" for "enzyme" that, as Housey urged, "include a direct-binding limitation." Pet. App. 9a. The majority noted that the dictionary definitions are written in terms of inhibitors/activators of "enzymes," but did not explain why the same definitions are not available for proteins generally. And the majority asked only whether those definitions established "the plain meaning," not whether they established *available* meanings (*id.*)—a critical reformulation, because if binding were even a permissible meaning, the specification and prosecution history would supply the context for discerning the right meaning, with no burden to overcome a presumptively clear contrary meaning. *Id.*

As to the specification, the majority never discussed key aspects—those, quoted above, which focus the patented method's advance over prior art on its distinguishing among cell-property-affecting substances based on the mechanisms of achieving that effect. In particular, the majority made no mention of the specification's emphasis on the absence of that distinguishing ability as a fundamental limitation of prior-art methods. The majority did recognize the specification's repeated emphasis that the method identifies activators or inhibitors "specific" or "absolutely specific" to a target protein (Pet. App. 11a-12a), but it deemed those passages insufficient

to "lead to a strong inference of direct binding." *Id.* at 12a. It never explained how those passages could be squared with the construction *it* adopted, however, and it did not discuss the evidence, partly set forth in the dissent (*id.* at 22a), that a number of experts, including one adversarial to Housey, understood "specific" to refer to binding.

Beyond explaining away material urged by Housey as supporting its construction, the majority opinion relies on just a few passages as affirmatively pointing the other way. The majority cited three passages in the specification (Pet. App. 10a, 11a), two of which (Col. 6, ll. 37-40, 40-42) on their face are not even addressed to *how* cellular properties are altered (by binding to the protein or by some other action in a biological pathway), but only to *how much* alteration is required. (The third is discussed at page 27, *infra*.) The majority also relied on a passage from the prosecution history about the standard situation where a protein resides within a molecular complex, reading the passage as allowing for inhibitors or activators to affect any aspect of a particular biological pathway. Pet. App. 11a. That is a misreading, as discussed at pages 28-29, *infra*.

Finally, the majority dismissed the venerable principle that patent claims should be "'so construed, if possible, as to sustain their validity.'" Pet. App. 14a. The majority said that, unless it was itself determining validity, the principle was inapplicable—despite respondents' *stipulation* that their proposed construction invalidates the patents. *Id.* In any event, the majority said in a single sentence that the principle was not "dispositive" here, because it had already determined the proper construction without regard to that principle. *Id.*

Judge Newman dissented. Pet. App. 15a-22a. She disagreed with what she described as the majority's treatment of the specification as "an also-ran in claim construction," when it should be "the primary resource in understanding the claims." Pet. App. 17a; *id.* at 15a-19a. More pointedly, "the

majority's proposed 'plain meaning' differs from the specification's statement of the invention." Pet. App. 19a. In particular, on the crucial matter of identifying the advance over prior art, "[t]he patent documents state that the invention concerns 'direct modulation,' and that the prior art shows primarily 'indirect modulation' of intermediate agents." *Id.* Judge Newman quoted expert testimony, stressed the importance of construing claims to avoid invalidity where reasonably possible, and urged a remand "for resolution of conflicting scientific evidence, and re-determination of the meaning and scope of the correctly construed claims." Pet. App. 21a-22a.

REASONS FOR GRANTING THE PETITION

This case presents an opportunity for this Court to restore a focus on substance and sense to the task at the heart of the vast bulk of patent cases—claim construction, *i.e.*, the interpretation of the claims of a patent, which define the protected invention. The fundamental goal of claim construction is to "ascertain[] the invention," by reference to the entire document. *United States v. Adams,* 383 U.S. 39, 49 (1966) ("[C]laims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention."). Yet the Federal Circuit has, in a number of cases, conducted claim construction as an almost mechanical exercise that loses sight of its proper objective: to capture the invention as accurately as possible in order to ensure a commensurate patent reward. That misguided approach destroyed Housey's patents in this case.

There is urgent need for clarification, as confirmed by the Federal Circuit's recent decision broadly to address claim-construction principles en banc. *Phillips v. AWH Corp.*, 376 F.3d 1382 (Fed. Cir. 2004). The clarification that is needed must reflect the basic recognition that, given the inevitable imperfections of language, the patent system cannot continue to fulfill its mission of spurring invention unless claim con-

struction is returned to a more context-dependent, realistic inquiry to resolve genuine linguistic uncertainty in favor of a sensible definition of what the patentee invented. Clarification along just those lines is the natural next step following this Court's recent decisions resolving matters fundamental to patent law based on appreciation of the difficulties of patent language and the need for context-dependent interpretation. *See Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 389 (1996); *Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 34-35 (1997); *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731-32 (2002). Nothing is more fundamental in patent law than the proper construction of claim language, which affects both validity and infringement issues in the great majority of patent cases.

The analysis by the panel majority in this case exemplifies claim-construction approaches that lose sight of the "does this make sense" question that should overhang, drive, and constantly inform the inquiry. The adopted construction make no sense as a definition of the invention as the patentee conceived it and the PTO understood it. Indeed, the adopted construction, by bizarrely turning a highly informative but inevitably imperfect method of screening for something into the definition of the thing being sought, renders the patent claims essentially tautological and circular, undisputedly invalidates the patents, and ignores the patent's explanation of the key point of distinction over prior-art methods. The panel majority's analysis and result in this case fall so far from the mark of capturing the actual invention that this case is a good vehicle for re-establishing a sensible realism in claim construction as the natural next step in this Court's recent course of clarifying important foundations in patent law along such lines.

I. THE PROPER APPROACH TO PATENT CLAIM CONSTRUCTION IS INDISPUTABLY IN NEED OF CLARIFICATION

Conflicts among Federal Circuit decisions establish the need for clarification of the proper approach to construing patent claims. Thus, the panel majority in this case adopted a claim construction that senselessly renders the claims tautological, effectively writing a whole clause (a claim limitation) out of the claims (pages 22-24, *infra*), whereas elsewhere the Federal Circuit has rejected claim constructions precisely where they "would make [a claim] limitation entirely circular" so as to "contribute nothing but meaningless verbiage to the definition of the claimed invention" (*Harris Corp. v. IXYS Corp.*, 114 F.3d 1149, 1152 (Fed. Cir. 1997)) or render claim language "surplusage" (*Texas Instruments Inc. v. ITC*, 988 F.2d 1165, 1171 (Fed. Cir. 1993)) or "meaningless" (*Unique Concepts, Inc. v. Brown*, 939 F.2d 1559, 1563 (Fed. Cir. 1991)). Similarly, the majority here ignored the patents' discussion of prior art limitations and how this invention overcame them (page 26, *infra*), whereas other Federal Circuit decisions rely centrally on such discussions. *E.g., Eastman Kodak Co. v. Goodyear Tire & Rubber Co.*, 114 F.3d 1547, 1554 (Fed. Cir. 1997), *limited in other respect, Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448 (Fed. Cir. 1998); *Minnesota Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1566 (Fed. Cir. 1992).

Federal Circuit precedents also diverge on the principle that claims should be construed to avoid invalidity where possible. A number of Federal Circuit decisions (following this Court's precedents, *see* page 18, *infra*) have relied heavily on this principle from the outset of analysis, informing the entire claim construction as it proceeds, testing the soundness of provisional conclusions along the way. *Carman Indus., Inc. v. Wahl*, 724 F.2d 932, 937 n.5 (Fed. Cir. 1983); *ACS Hospital Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577 (Fed. Cir.

1984); *see also Whittaker Corp. v. UNR Indus., Inc.*, 911 F.2d 709, 712 (Fed. Cir. 1990). Recently, however, Federal Circuit decisions have relegated the avoid-invalidity principle to the status of an afterthought, first engaging in claim construction without regard to invalidity consequences, and only then mentioning the invalidity-avoidance principle—either making it a needless confirmation of the conclusion already reached or dismissing the principle on the ground that it cannot overcome the conclusion already reached. *E.g., Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 911 (Fed. Cir.), *cert. denied*, 125 S. Ct. 316 (2004); *AK Steel Corp. v. Sollac & Ugine*, 344 F.3d 1234, 1243 (Fed. Cir. 2003); *Generation II Orthotics Inc. v. Med. Tech. Inc.*, 263 F.3d 1356, 1365 (Fed. Cir. 2001).

More broadly, the Federal Circuit has in a number of cases so veered off the course of context-dependent realism in claim construction (as the dissent explains) that the court as a whole has now formally recognized that its precedents have created widespread confusion about the proper approach to claim construction. In July 2004, the Federal Circuit granted en banc review in *Phillips v. AWH Corp.*, 376 F.3d 1382 (Fed. Cir. 2004), to consider broad questions about claim construction—particularly, the strength of any presumptive conclusion about meaning from the claim language alone, as well as the role of the principle of avoiding constructions that needlessly produce invalidity.[5] *See also C.R. Bard, Inc. v.*

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[5] 376 F.3d at 1383: "1. Is the public notice function of patent claims better served by referencing primarily to technical and general purpose dictionaries and similar sources to interpret a claim term or by looking primarily to the patentee's use of the term in the specification? If both sources are to be consulted, in what order?

2. If dictionaries should serve as the primary source for claim interpretation, should the specification limit the full scope of claim language (as defined by the dictionaries) only when the patentee has acted as his own lexicographer or when the specification reflects a clear disclaimer of claim scope? If so, what language in the specification will satisfy those conditions? What use should be made of general as opposed to technical

dictionaries? How does the concept of ordinary meaning apply if there are multiple dictionary definitions of the same term? If the dictionary provides multiple potentially applicable definitions for a term, is it appropriate to look to the specification to determine what definition or definitions should apply?

3. If the primary source for claim construction should be the specification, what use should be made of dictionaries? Should the range of the ordinary meaning of claim language be limited to the scope of the invention disclosed in the specification, for example, when only a single embodiment is disclosed and no other indications of breadth are disclosed?

4. Instead of viewing the claim construction methodologies in the majority and dissent of the now-vacated panel decision as alternative, conflicting approaches, should the two approaches be treated as complementary methodologies such that there is a dual restriction on claim scope, and a patentee must satisfy both limiting methodologies in order to establish the claim coverage it seeks?

5. When, if ever, should claim language be narrowly construed for the sole purpose of avoiding invalidity under, *e.g.*, 35 U.S.C. §§ 102, 103 and 112?

6. What role should prosecution history and expert testimony by one of ordinary skill in the art play in determining the meaning of the disputed claim terms?

7. Consistent with the Supreme Court's decision in *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 ... (1996), and our *en banc* decision in *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448 (Fed. Cir.1998), is it appropriate for this court to accord any deference to any aspect of trial court claim construction rulings? If so, on what aspects, in what circumstances, and to what extent?"

Judge Rader separately asked for comment on the following: "Is claim construction amenable to resolution by resort to strictly algorithmic rules, e.g., specification first, dictionaries first, etc.? Or is claim construction better achieved by using the order or tools relevant in each case to discern the meaning of terms according to the understanding of one of ordinary

United States Surgical Corp., 2004 WL 2414612, at *3 (Fed. Cir. Oct. 29, 2004) (describing divergent approaches within Federal Circuit decisions). The need for clarification of claim-construction principles is definitively established by the grant of en banc review in *Phillips*—and by the roughly three dozen amicus briefs, including one by the United States, that have been filed to address these fundamental questions.

II. THIS COURT'S PRECEDENTS SUPPLY PROPER CLAIM CONSTRUCTION PRINCIPLES

Under this Court's precedents, the proper approach to claim construction is one that is substance-driven, always recognizing that claims define the protected invention but looking to the entire patent document to determine how to construe the claim terms, constantly with an eye on the critical question of how sensibly to read the claims so as to capture the invention, and to avoid needlessly adopting a patent-invalidating construction. That substance- and sense-driven approach gives patents their due and provides the proper public notice of patent scope to those skilled in the art.

This Court set out the basic principles in *Bates v. Coe*, 98 U.S. 31, 38-39 (1878) (cited in *Markman*, 517 U.S. at 389). Although patentees are limited to their claims, notwithstanding greater breadth in the specification, "it is equally true that the claims of the patent, like other provisions in writing, must be reasonably construed, and in case of doubt or ambiguity it is proper in all cases to refer back to the descriptive portions of the specification to aid in solving the doubt or in ascertaining the true intent and meaning of the language employed in the claims . . . . In construing patents,

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skill in the art at the time of the invention, thus entrusting trial courts to interpret claims as a contract or statute?" 376 F.3d at 1384.

Chief Judge Mayer opposed en banc consideration as pointless until the Federal Circuit reconsiders the rule that claim construction is subject to *de novo* review on appeal. *Id.*

it is the province of the court to determine what the subject-matter is upon the whole face of the specification and the accompanying drawings."

In *Klein v. Russell*, 86 U.S. (19 Wall.) 433, 466 (1874), the Court already had insisted that "[t]he subject is to be examined in the light of [the] specifications and of [the] sets of claims." Importantly, the Court added a vital interpretive principle: "The court should proceed in a liberal spirit, so as to sustain the patent and the construction claimed by the patentee himself, if this can be done consistently with the language which he has employed." Even that principle was not new, for the Court had earlier ruled that "[p]atents . . . are to receive a liberal construction, and under the fair application of the rule, ut res magis valeat quam pereat, are, if practicable, to be so interpreted as to uphold and not to destroy the right of the inventor." *Turrill v. Michigan S. & N.I. R.R.*, 68 U.S. (1 Wall.) 491, 510 (1864). The principle of avoiding patent-invalidating constructions, if possible, reflects the deference due the patent-issuance decision of the expert PTO—as required by Congress's command that patents "be presumed valid." 35 U.S.C. § 282.

In *Smith v. Snow*, 294 U.S. 1, 14 (1935), the Court confirmed the necessary substantive focus. It explained that "if the claim [is] fairly susceptible of two constructions, that should be adopted which will secure to the patentee his actual invention." In *United States v. Adams*, 383 U.S. at 48-49, the Court again stressed that "claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention."

In *Markman*, 517 U.S. at 389, the Court, in establishing claim construction as a matter for judges rather than juries, relied on *Bates* and emphasized that the task of construction was one of substance-focused understanding of the document as a whole. Claim construction requires a "necessarily sophisticated analysis of the whole document, required by the

standard construction rule that a term can be defined only in a way that comports with the instrument as a whole." *Id.* (citing *Bates* and other sources). Any proposed interpretation must be evaluated "in relation to the overall structure of the patent"; the issue is whether it "fully comports with the specification and claims and so will preserve the patent's internal coherence." *Id.* at 390.[6]

The context-dependent approach to claim construction is reinforced by other recent decisions. In *Warner-Jenkinson*, 520 U.S. at 34-35, the Court, in affirming the persistence of the doctrine of equivalents as a kind of infringement beyond the literal meaning of claim terms, recognized that the doctrine responds to the need for realism and some flexibility in protecting inventions. In *Festo*, 535 U.S. at 731-32, the Court rejected the Federal Circuit's unduly mechanical and rigid limits on the doctrine of equivalents, repudiating "literalism" in claim "interpretation" in recognition of the inevitable imprecisions of claim language. *Id.* at 731-32 (because "the nature of language makes it impossible to capture the essence of a thing in a patent application," "the clearest rule of patent interpretation, literalism, may conserve judicial resources but is not necessarily the most efficient rule").

Proper claim construction under those decisions can and should be orderly and systematic in striving for a substantively correct understanding, without being mechanical, blinkered, formulaic, "algorithmic" (Judge Rader's term in the *Phillips* grant of en banc review, 376 F.3d at 1384). For example, *if* a claim term has a clear meaning, that meaning can generate a presumption of correctness; whereas if no "precise and well-established meaning in the art" exists, the meaning, while properly limited to the range of available

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[6] *See also* 517 U.S. at 387 (noting frequent need for non-expert judges, seeking to construe the "tenor" of a patent, to receive expert testimony to understand the meaning of technical terms).

meanings of the claim words, necessarily must be sought from context.[7] Differences among different claims' language—in the issued patent or in initial applications leading to the patent or related patents—may reveal both a broad or unmodified term, on one hand, and a narrow or modified term, on the other, suggesting a broad meaning of the former by comparison to the narrower meaning of the latter.[8] The specification can make clear an intended meaning, either by express definition or by clear, otherwise-unqualified characterization of the *invention*, especially statements distinguishing it from prior art; while specification statements that serve quite different statutory purposes—describing particular *embodiments*, to teach skilled artisans how to make and use the invention and to set out the best mode the inventor knows of practicing it (35 U.S.C. § 112, ¶ 1)—must not be transformed into limitations on the *invention*.[9] And the prosecution history, aside from showing differences among (issued or proposed) claims, can illuminate the meaning accepted by the patentee and examiner in various ways: *e.g.*, it may expressly state a narrow or broad intended meaning, or it may reveal that the examiner recognized the presence of multiple separate inventions in an initial application and required them

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[7] *On-Line Technologies, Inc. v. Bodenseewerk Perkin-Elmer GmbH*, 386 F.3d 1133, 1137 (Fed. Cir. 2004); *Irdeto Access, Inc. v. Echostar Satellite Corp.*, 383 F.3d 1295, 1300 (Fed. Cir. 2004); *Rambus Inc. v. Infineon Technologies AG*, 318 F.3d 1081, 1088, 1094 (Fed. Cir. 2003).

[8] *Liebel-Flarsheim*, 358 F.3d at 909; *Rambus*, 318 F.3d at 1095; *see Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966) ("claims that have been narrowed in order to obtain the issuance of a patent by distinguishing the prior art cannot be sustained to cover that which was previously by limitation eliminated from the patent").

[9] *C.R. Bard*, 2004 WL 2414612, at *5; *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1348 (Fed. Cir.), *cert. denied*, 125 S.Ct. 61 (2004); *Bell Atlantic Network Serv., Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258 (Fed. Cir. 2001); *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337 (Fed. Cir. 2001).

to be split up into separate applications (revealing the independence of the multiple inventions).[10]

Such subsidiary principles can thus discipline and guide claim construction toward an understanding of claim language that captures what a skilled artisan would understand to be the invention. A substance-focused, sense-driven, context-dependent approach to understanding claim language can provide systematic guidance to applicants and examiners during patent prosecution and to the public thereafter. As IBM *et al.* recently stated in their *amicus* brief in the *Phillips* case (www.patentlyobviousblog.com/files/IBM.pdf, at 18), "[t]ying the meaning of claim terms to the principle of the patentee's actual invention reduces uncertainty."[11]

The United States's recent brief in the *Phillips* case (*see* www.patentlyobviousblog.com/files/govt_phillips_brief.pdf) discusses a number of these principles. It points out that the PTO, in examining patent applications, focuses on the context provided by the specification. *Id.* at 11 (citing PTO rule, 37 C.F.R. § 1.175(d)(1)). It stresses *Markman*'s emphasis on the "'necessarily sophisticated analysis of the whole [patent] document required by the standard construction rule that a term can be defined only in a way that comports with the instrument as a whole.'" *Id.* at 15 (quoting 517 U.S. at 389). Pointing to the statutory presumption of validity, it endorses the principle of avoiding invalidating constructions where more than one interpretation is reasonable. *Id.* at 16. And it notes with evident approval decisions that construe claims "to encompass a feature that the specification describes as essen-

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[10] *E.g.*, *Honeywell v. Victor Co. of Japan, Ltd.*, 298 F.3d 1317, 1323-24 (Fed. Cir. 2002); *Rambus*, 318 F.3d at 1095.

[11] That brief notes (at 8, 9) the cacophony within the Federal Circuit, as "the meaning of patent claims is being divorced from the context of the invention itself," with an often-unjustified insistence on a "so-called 'plain meaning[,]'" which "may be entirely divorced from the specification and file history, and thus from the intent of the patentee."

tial to the invention, or that the specification used to distinguish the prior art." *Id.* at 19. Much of the discussion, if not every point, supports establishment of the approach to claim construction we urge.

III. THIS CASE IS A GOOD VEHICLE FOR ESTABLISHING THE PROPER SUBSTANCE-FOCUSED, SENSE-DRIVEN, CONTEXT-DEPENDENT APPROACH TO CLAIM CONSTRUCTION

This case is a good example of what goes wrong when a court conducts claim construction mechanically, with blinkers on that shut out the central question of claim-construction inquiry: does the proposed construction sensibly capture the substance of the advance over prior art that is the invention? Rejection of the majority's claim construction would automatically require setting aside the Federal Circuit's judgment.

A. The majority did not conclude, or cite anything to show, that "inhibitor or activator of a protein" carries the adopted construction as its "precise and well-established meaning in the art." *On-Line Tech.*, 386 F.3d at 1137. Instead, the majority briefly asserted that a positive result in the screening method—a differential effect on the test and control cell lines—*defined* what the test is screening for: any such "substance is, as defined by the claimed method itself, an inhibitor or activator of the protein of interest." Pet. App. 7a. That opening and result-determining step, Housey respectfully suggests, makes no sense.

Inserting the majority's definition into the claim produces a nonsensical tautology. The claim effectively becomes: "A method of determining whether a substance is a substance that has a differential effect on certain test- and control-cell lines, comprising observing whether it has a differential effect on those test- and control-cell lines." That construction makes the opening phrase meaningless surplusage; the claim

becomes "entirely circular," with the phrase "contribut[ing] nothing but meaningless verbiage to the definition of the claimed invention." *Harris*, 114 F.3d at 1152.

The majority's construction contradicts ordinary usage. A method of "screening for" something, an "assay" for something (Pet. App. 2a), starts with an *already defined object of search* and tells investigators when they have likely found it. The pre-assay understanding of the object of search is what motivates investigators to design ways to find it. It would be bizarre, if conceivable at all, for a patent claiming a way of "screening for," "discover[ing]," "identif[ying]," something (Col. 1, ll. 8, 11) to define what is being sought by the results of the method for finding it. The majority's construction is analogous to *defining* "perpetrator" (the person who actually committed a crime) as the person identified in a lineup.

That the majority's construction makes no sense is starkly confirmed by the fact that, under it, the "method of determining" (whether a substance is an inhibitor or activator of a protein) is, by definition, inevitably perfect. Anything with the differential effect necessarily and automatically is, by this construction, an "inhibitor or activator of a protein"; and anything not, not. That inescapable consequence of the majority's definition flatly contradicts the district court's construction of the claim language "method of determining" as meaning ascertaining to a high probability but not with 100% certainty. Pet. App. 30a. The Federal Circuit did not question that construction; the Merck group of respondents in the Federal Circuit did not even challenge it.[12] And it is plainly correct, for, as the district court rightly concluded,

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[12]Another group did not challenge it on *textual* grounds, but merely argued—incorrectly—that Dr. Housey somehow disclaimed the natural meaning of "determining" while prosecuting his applications, an assertion the district court properly rejected.

"determining" here, as in science generally, provides only a "high degree of probability," not certainty, let alone definitional certainty. The majority's construction misunderstands that basic point.

Nor is the majority's construction made sensible by the two specification statements it cites in its second paragraph explaining that its result-as-definition construction is "logical." Pet. App. 7a-8a. The two statements say that the new method allows investigators to "distinguish[]," to "identif[y]," the looked-for "substances which specifically inhibit or []activate the POI," "[i]nhibitors or activators." *See id.* These are statements about how to discover, or find, something, not what defines it.

The majority's construction thus makes no sense, and the two paragraphs set forth to justify that construction do not in fact do so. Moreover, counting against that construction is the consequence that it renders the patents invalid, thus overturning the presumptively correct decision of the PTO to issue the patents. The majority gave no weight to the avoid-needless-invalidity principle in its claim-construction analysis. Specifically, there is no sound reason why the principle is inapplicable when the proponents of the invalidating construction have actually stipulated that invalidity results.

B. The rest of the majority opinion rejects Housey's construction of the claim phrase, "inhibitor or activator of a protein"—a substance that specifically attaches (binds) to the protein molecule (which may be a multi-part complex in which some subunit proteins sometimes reside) to prevent or allow its functioning in intracellular processes. Contrary to the majority, Housey's construction makes sense of the claim language, patent specification, and prosecution history—far better sense as an understanding of the protected invention than the majority's construction.

The majority acknowledged dictionary definitions that *do* require binding for "inhibitor" or "activator" as one standard meaning for the terms as applied to enzymes, one kind of protein. Pet. App. 9a. But the majority never even asked the question whether this meaning was a *permissible* one as applied to proteins more generally. Instead, it concluded only that this was not "the plain meaning" of the phrase, which is the wrong question. *Id.* And the majority suggested no sensible reason that the concededly available "binding" meaning for enzymes would not be available for "protein" in these patents. Indeed, Dr. Housey expressly claimed his method where "the protein is an enzyme" ('281 Patent, Claim 8), and the protein PKC, which is the focus of most of the specification, is identified in the patents themselves as an enzyme (Col. 6, ll. 47-49). If "inhibitor/activator" even for an *enzyme*—a protein defined by its *activity*—sometimes is limited to a particular method of modulating the activity (by binding), there is no good reason the same meaning would be unavailable for "protein" generally.

Expert evidence about how the claims would be understood undermines the majority's rejection of Housey's construction. Harvard Professor Dr. Griffin, a Housey expert, testified that the patent claims, read in light of the specification and with an understanding of the "improvement over the prior art," claim a method of finding substances that modulate the cellular functioning of the target protein *by* directly interacting with (*i.e.*, binding to) it. Declaration of Dr. Griffin dated June 7, 2002 at 1-3. Even Bayer's expert Dr. Fields, who was adversarial to Housey, testified that he understood that (a) the patent claims claim a method of discovering specific inhibitors or activators of a protein, (b) which means substances that modulate the effect of the protein by binding to it.[13]

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[13] Bayer expert Fields testified that "one aspect of being a specific activator or inhibitor is that it binds directly to that protein of interest." Fields Depo. dated July 2, 2002, at 91 (quoted at Pet. App. 21a). In the

The specification compellingly supports Housey's construction and undermines the majority's. Simply, the reading given by the majority destroys the distinction that the specification repeatedly says is central to the patented method: within the larger class of all substances that alter a particular cellular property, the differential effect on the test and control lines allows the investigator to separate those which achieve the property-altering effect by binding with the protein molecule from those substances which change the property by some *other* mechanism—by interacting with other proteins within cellular metabolic pathways. As quoted at pages 3-6, *supra*, that distinction is made not only in specification passages quoted by the majority, but in passages describing the limitations of prior-art methods and the advance represented by the new method, which is "absolutely specific" for a given protein (Col. 2, ll. 29-32). *E.g.*, Col. 3, ll. 5-10 ("Substances which specifically inhibit or [ ]activate the POI may be distinguished from substances which affect cell morphology or growth *by other mechanisms* . . . ."); Col. 6, ll. 18-20 ("*we distinguish inhibitors or activators of the POI from agents that act upon other cell metabolites to effect a phenotypic change*"). (Emphases added.) Housey's construction captures that distinction, which is at the heart of the invention, whereas the majority's obliterates it.

Nothing else in the specification can support overriding the key distinction. The only passage that even arguably could be read in isolation to suggest as much (though it does

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same deposition—in an excerpt submitted to the district court in the Bayer part of the claim-construction proceeding—Fields also testified that "it's my understanding that what Housey means *in this claim* is that this assay is one in which one can identify compounds that are specific inhibitors of or activators of the protein of interest, and that's the title." *Id.* at 48-49 (emphasis added). Fields thus made clear that specificity was part of his understanding of the *claim* (and *title* of the patent)—even without the word "specific" in the language—and that specificity entails binding.

nothing to support the majority's construction)[14] is the statement that properly created cell lines will "be sensitive in their growth properties to chemical agents which are capable of binding to, or modifying the biological effects of, the POI." Col. 6, ll. 30-33. But the ", or modifying" phrase cannot *reasonably* be read as disjunctive, as indicating that the claimed method covers *any* substance that modifies the phenotypic characteristic, even without binding to the POI. If the "or" is not just an imprecision ("or" where "and" belongs), the phrase can only sensibly be read as explanatory ("or, more precisely, modifying the effects of by binding to").

The phrase appears in a paragraph that is introduced "Thus" to illustrate the very sentence just quoted (Col. 6, ll. 18-20) that specifically *distinguishes* the substances identified by this method from "agents that act upon other cell metabolites to effect a phenotypic change." It is senseless to read the ", or modifying" phrase to repudiate that distinction, when it is introduced as exemplifying the distinction. Moreover, a few paragraphs later, the specification uses the same grammatical construction: "bind to, or are activated by, the phorbol ester tumor promoters." Col. 7, ll. 17-18. It is undeniable that, in this passage, the activating is *by binding*, not an alternative to binding. *See* Col. 14, ll. 18-63 (phorbol ester binding to PKC). The same grammatical construction just a few paragraphs earlier is naturally understood the same way, "modifying" *by binding*, not as suddenly and irrationally equating what the patents make a great effort to distinguish.

The prosecution history confirms rather than undermines Dr. Housey's repeated explanation of the essence of his

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[14] The majority also referred (Pet. App. 10a) to two observations in the specification (Col. 6, ll. 37-42) that address the *degree* and *timing* of the inhibitor/activator's effect on the POI's activity. Those passages are irrelevant here, because they do not even purport to address the *mechanism* by which that effect is achieved (binding or something else), which is the point in dispute—as the majority elsewhere noted (Pet. App. 12a).

invention—a new cellular assay that can pick out the specific protein-targeting substances from the larger class of substances that can alter cellular functioning by other mechanisms (with all their potential harmful unwanted side-effects of such nonspecificity). The majority mistakenly read Dr. Housey's statement, in the prosecution history, that certain prior art did not "provide the target protein/ biochemical pathway specificity of the present invention." Pet. App. 11a. That statement simply does not say that the present invention involves any substance that is specific to *either* the target protein *or* a biochemical pathway. The slash (/) does not assert alternatives, but means action specific to the protein's functioning *in* a particular pathway. Indeed, the very passage quoted by the majority says that the new assay "'provides a *specificity between a target protein and its attendant biochemical pathways.*'" *Id.* (emphasis added).

The majority also overread Dr. Housey's prosecution-history statement that inhibitors or activators "'will be found to interact directly with the target protein itself and/or with other proteins in which the target protein also interacts in the form of dimeric or multimeric complexes.'" *Id.* Even by its terms, this statement does not allow interaction with *any* cell component that produces the cell-property difference (the majority's construction); it refers only to interaction with "dimeric or multimeric complexes." This is a narrow, familiar category of proteins consisting of already-conjoined complexes in which catalytic and regulatory subunit proteins often reside (as with the featured PKAc (Col. 7, ll. 32-33); *see* Alberts, *supra*, at 857), so the searched-for inhibitor/activator can interact with the complex (itself a POI) by interacting with any of its subunits. This is hardly a retraction of the key distinction made not only in the specification, but in the very document containing the quoted passage—which distinguishes the prior art being discussed precisely on the ground that its method is *not* limited to "substances which directly interact with the target protein." Declaration of Gerard M.

Housey dated Oct. 22, 1996 (¶¶ 15, 16, 19(a)). The document thus reinforces, rather than undermines, the critical distinction overriden by the majority's construction.

Dr. Housey emphasized this distinction in responding to an examiner rejection of certain claims as anticipated by a patent issued to Sonnenschein. Amendment dated May 26, 1994. Dr. Housey distinguished Sonnenschein on the ground that it used broad definitions of "estrogens" and "anti-estrogens" so that "any substance which exhibits the properties embodied in these definitions, *whether or not it activates or inihibits an estrogen receptor protein*, will be categorized as an estrogen agonist [activator] or antagonist [inhibitor]." *Id.* at 5 (emphasis added). The difference was between protein interaction specifically and "activity" modulation generally: "It is important to note the difference between an estrogen *receptor* agonist or an estrogen *receptor* antagonist as compared to a substance which exhibits estrogenic or anti-estrogenic activity as defined by the inventors. *The latter may interact with some other protein or non-protein molecule. Thus, the methodology of the [Sonnenschein] reference provides no target protein specificity, which is the essential point of the present invention.* " *Id.* at 5-6 (last emphasis added).

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The patent-invalidating claim construction adopted in this case should not be allowed to stand. It is incorrect, and the case is a good vehicle for providing needed review of claim-construction principles. The Court should grant review now if respondents insist that the en banc Federal Circuit in *Phillips* will assuredly do nothing to affect the ruling in this case, for that can happen only if *Phillips* does not establish proper claim-construction principles. Otherwise, the Court may wish to hold the petition pending the *Phillips* decision. Once *Phillips* is decided, the Court can readily assess whether it establishes a "reasonable probability" of a different analysis

in this case, justifying a GVR here (*Lawrence v. Chater*, 516 U.S. 163, 167 (1996)), or whether claim-construction principles should be reviewed in this case or in *Phillips* itself. Regardless, the patent-defeating ruling in this case, resting on a fundamentally faulty analysis, should not be permitted to become final.[15]

CONCLUSION

The petition for a writ of certiorari should be granted.

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November 22, 2004

[15] The present petition is unlike recent petitions seeking to *broaden* sensibly context-specific decisions of the Federal Circuit. *Multi-Tech Systems, Inc. v. Microsoft Corp.*, 125 S. Ct. 61 (2004) (No. 03-1719); *Gaus v. Conair Corp.*, 125 S. Ct. 346 (2004) (No. 04-196). It is also unlike the unsuccessful petition (125 S. Ct. 216 (2004) (No. 04-32)) from the decision in *Liebel-Flarsheim*, which was interlocutory (allowing *Phillips* to be applied at later stages of the case) and which did undertake the critical contextual analysis (relying on claim differentiation and prosecution-history broadening). The present petition challenges a final Federal Circuit decision that mistakenly blinds itself to context and thus adopts too broad a construction.